

### REMARKS

Claims 4-10, 17 and 18 are withdrawn. Claims 13 and 16 have been amended. Claims 1, 3 and 11-16 are pending.

### Election/Restrictions

Claims 17 and 18 are withdrawn in accordance with the Election/Restrictions of paragraph 4.

### Claim Objections

Claim 13 has been amended at line 15 to add the word -- film -- following the phrase "the remaining oxidation-resistant" as suggested by the Examiner.

### Claim Rejections – 35 U.S.C. 112

Claim 16 has been amended to recite the limitation "selectively etching the tunnel insulating film except from on the region of the semiconductor substrate where the MOS transistor is to be formed." As the Examiner pointed out, this will conform to Figure 6 where the tunneling insulating film 16 is formed over the gate insulating film 13 and under the gate layer 18. No new matter has been added.

The Applicant respectfully requests withdrawal of the 35 U.S.C. 112 rejection.

### Claim Rejections – 35 U.S.C. 103

The Final Action rejected claims 1, 3 and 11-15 under 35 U.S.C. 103 as unpatentable over Komori et al. in view of Hsieh et al. The Applicant respectfully traverses this rejection.

Independent claims 1, 11 and 13 recite the limitation of simultaneously and selectively forming an oxide film on the region where the floating gate is to be formed and a gate insulating film on the region where the MOS transistor is to be formed.

The mere fact that references could be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the

combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). *See also, In re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992).

The Office action asserts that Komori et al. teaches simultaneously forming an oxide film (8) on the region where the floating gate is to be formed and a gate insulating film (8) on the region where the MOS transistor is to be formed (Fig. 4). While this may be true, the gate insulating film (8) is formed simultaneously as a continuous layer as shown in Fig. 4. There is no suggestion in Komori et al. that it would be desirable to form the oxide film and the gate insulating film selectively as recited in claims 1, 11 and 13. Indeed, in Komori et al. the gate insulating film is not selectively formed or even subsequently etched away in the region where the MOS transistor is to be formed. (See Figs. 5-10) Hence, there is no indication or suggestion of the desirability of selectively forming the gate insulating film.

Hsieh et al. discloses a method for forming a non-volatile memory transistor only. Hsieh et al. does not disclose any MOS transistor. Necessarily, there is no suggestion in Hsieh et al. of the desirability of selectively forming a gate insulating film in the region where a MOS transistor is to be formed simultaneously with forming an oxide film in a region where a floating gate is to be formed.

That is, even assuming, *arguendo*, that the references can be combined, neither Komori et al. nor Hsieh et al. provides any motivation or desirability to form the layer in question selectively and simultaneously where the MOS gate is to be formed.

Thus, claims 1, 11 and 13 are not obvious in view of Komori et al. and Hsieh et al. at least because there is no disclosure or suggestion of the limitation of selectively forming a gate insulating film in the region where a MOS gate is to be formed as recited in those claims. Also, there is no suggestion or motivation in either reference of the desirability of combining the references to attain the claimed subject matter.

The Applicant respectfully requests withdrawal of the 35 U.S.C. 103 rejection.

In addition, to establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ

580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

The Office action alleges that Hsieh et al. discloses the limitation of selectively forming the oxide film on the region where the floating gate is to be formed. (Top of page 6). The floating gate, however, is not part of an MOS transistor. Indeed, Hsieh does not disclose any MOS transistor. Therefore, Hsieh et al. does not disclose the limitation of selectively forming the oxide film on the region where the MOS transistor is to be formed as recited claims 1, 11 and 13. Komori either alone or in combination does not render the present application obvious.


Komori et al. may disclose the forming of an MISFET (MOS) gate and a floating gate transistor on the same substrate, but it does not disclose selectively forming an oxide film on both the region where the MISFET is to be formed and where the floating gate is to be formed. Hsieh et al. discloses only forming of a floating gate. Furthermore, Hsieh et al. does not disclose the forming of a MOS gate. Hence, although Hsieh et al. may disclose forming an oxide layer in the region where the floating gate is to be formed, Hsieh et al. necessarily does not disclose selectively forming an oxide in the region where a MOS gate is to be formed.

For the above additional reason, the Applicant respectfully requests withdrawal of the 35 U.S.C. 103 rejection.

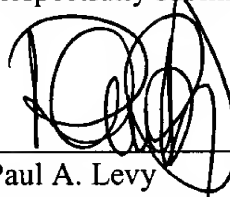
Claims 3, 12 and 14-16 depend from one of claims 11 or 13 and should be allowable for at least the same reasons.

The Applicant does not believe that any fees are due at this time. However, please apply any charges or credits to deposit account 06-1050.

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